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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,925	08/28/2001	James E. Dahlberg	FORS-06612	6817
23535	7590	01/16/2004	EXAMINER	
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			SULLIVAN, DANIEL M	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,925

Applicant(s)

DAHLBERG ET AL.

Examiner

Daniel M Sullivan

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 71-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 71-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

This Office Action is a reply to the Amendment and Response of 4 August 2003 filed in response to the Non-Final Office Action mailed 17 June 2003. Claims 71-94 were considered in the previous Office Action. Claims 71, 84 and 94 were amended in the 4 August Paper. Claims 71-94 are presently pending and under consideration.

Response to Amendment

The amendment to the specification has been entered.

Drawings

The drawings stand objected to for the reasons indicated on the PTO-948 that mailed with the previous Office Action. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. **Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings

Art Unit: 1636

should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.

Claim Objections

Objection to claim 84 is withdrawn.

Claim Rejections - 35 USC § 112

Rejection of claim 71, and claims depending therefrom, and claim 94 under 35 U.S.C. §112, second paragraph, is withdrawn.

Claim Rejections - 35 USC § 102

Claims 71-75, 77-81, 87, 88 and 92-94 stand rejected under 35 U.S.C. 102(b) as being anticipated by US 4,994,368 (Goodman et al.) for reasons set forth in the previous Office Action and herein below in the response to arguments.

Claim Rejections - 35 USC § 103

Claims 71-81, 87, 88 and 92-94 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US 4,994,368 (Goodman et al.) in view of US 5,994,056 (Higuchi et al.) for reasons set forth in the previous Office Action and herein below in the response to arguments.

Claims 71-88 and 92-94 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US 4,994,368 (Goodman et al.) in view of US 5,994,056 (Higuchi et al.) as applied to claims 71-81, 87, 88 and 92-94 above, and further in view of US 5,210,015 (Gelfand et al.) for reasons set forth in the previous Office Action and herein below in the response to arguments.

Claims 71-94 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman et al.) in view of US 5,994,056 (Higuchi et al.) and further in view of US 5,210,015 (Gelfand et al.) as applied to claims 71-88 and 92-94 above, and further in view of US 4,935,357 (Szybalski) for reasons set forth in the previous Office Action and herein below in the response to arguments.

Response to Arguments

In response to the art rejections on record, Applicant alleges that the instant invention is distinguished from the prior art because the art fails to teach providing first and second oligonucleotides which have different nucleic acid sequences. Applicant urges that Goodman *et al.* teaches providing *identical* first and second oligonucleotides and will fail if the first and second oligonucleotides are not identical.

This argument has been fully considered but is not found persuasive. Beginning in column 14 at line 44, Goodman *et al.* contemplates a method (B), which is illustrated in Figure 2. In the method, a target nucleic acid is denatured and hybridized with a first nucleic acid. Also comprised within the mixture is the complementary strand of the target nucleic acid, which meets the definition of an oligonucleotide as it is set forth on page 29 of the specification and also meets the limitations of a second oligonucleotide comprising a nucleic acid sequence different from the first oligonucleotide. The complementary strand would hybridize to the target nucleic acid in those regions not occupied by the first nucleic acid; therefore, the target sequence, first nucleic acid and second nucleic acid (i.e., strand complementary to the target sequence) would form a first complex. As described in the previous Office Action, the method of Goodman *et al.* also comprises cleavage of the first complex to liberate the 5' portion of the first oligonucleotide, which is then reacted with a third oligonucleotide to form a second complex that is cleaved to form a detectable second cleavage product. Thus, Goodman *et al.* does, in fact, teach a method comprising a second oligonucleotide, wherein said oligonucleotide comprises a nucleic acid sequence different than said first oligonucleotide. Therefore, the amended claims are anticipated by or unpatentable over the teachings of the prior art for reasons of record in the previous Office Action and herein.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1636


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M Sullivan whose telephone number is 703-305-4448. The examiner can normally be reached on Monday through Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on 703-305-1998. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Please note: Art Unit 1636 will be moving to the new USPTO facilities on 14 January 2004. After that date, Examiner Sullivan can be reached at 571-272-0779 and Examiner Yucel can be reached at 571-272-0781.


DAVID GUZZI
PRIMARY EXAMINER

DMS